



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,567	04/12/2004	Jimmie D. Burrow	125447-1005	2641

7590 01/26/2009
MICHAEL E. MARTIN
GARDERE WYNNE SEWELL LLP
1601 ELM STREET, SUITE 3000
DALLAS, TX 75201

EXAMINER

HIGGINS, GERARD T

ART UNIT	PAPER NUMBER
----------	--------------

1794

MAIL DATE	DELIVERY MODE
-----------	---------------

01/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,567	Applicant(s) BURROW ET AL.	
	Examiner GERARD T. HIGGINS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-35 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on 12/09/2008 has been entered. Currently claims 29-35 and 37-44 are pending, claims 1-28 are cancelled, and claims 39-44 are new.

Claim Objections

2. Claims 30, 40, and 43 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 29 and 37 state that said member is both "flexible and indentable;" however, claims 30 and 40 seek to broaden this by stating the plastic material forming said member is **only** flexible and is not necessarily indentable. Perhaps applicants meant to claim that "said image sheet and said member are formed of a plastic material."

With regard to claim 43, pending clarification the Examiner is treating the coating of claim 43 as the same coating seen in claim 42; therefore, claim 43 fails to limit claim 42 because a coating has already been established in claim 42.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1794

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 37-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 37, the Examiner does not find support for claiming "a contour complementing the contour of the image sheet." The image sheet may be cut to a contour of the image itself; however, this does not necessarily mean that the member has "a contour complementing the contour of the image sheet."

With regard to claim 38, the Examiner does not find support for saying that the cover part further comprises a member and an image sheet. The cover part and the member appear to be interchangeable terms as they are the same thing. Applicants are not supported for saying the image sheet is apart of the cover part.

With regard to claim 39, the Examiner does not find support for saying that "said member and said image sheet are formed of the same material." While applicants are supported for claiming that "said member and said image sheet are formed of a plastic material" or that both are formed of polyvinyl chloride, they are not supported for broadly claiming that they may be **any** type of identical materials.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1794

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 29-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 29, the phrase "said article comprising" in the second line of the claim renders the claim indefinite because a portfolio can comprise an article but the article cannot comprise the portfolio etc. The claim is indefinite because it is unclear if the claim is drawn to an article, or to a portfolio, desk folder, etc. It has been held that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 29 recites the broad recitation "an article with a printed image thereon," and the claim also recites "a

Art Unit: 1794

portfolio, desk folder, wallet, luggage tag, memo pad, or keyfob” which is the narrower statement of the range/limitation.

With regard to claim 31, applicants are attempting to claim that image sheet is bonded to said member by "applying RF energy to **adhere** said image to said member," and also that "said second side of the image sheet is **welded** to said member." A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 31 recites the broad recitation "adhere," and the claim also recites "welded" which is the narrower statement of the range/limitation. Given the fact that applicants see a distinct difference between the words adhere and weld (see Remarks page 11), this provided additional impetus for the Examiner to set forth this rejection; furthermore, for purposes of examination the Examiner will treat the broader limitation adhere.

Claim 33 is also confusing since it appears as if the embossing should be on the coating and not under the coating, as is disclosed in the specification.

With regard to claim 37, the phrase “said article comprising” in the second line of the claim renders the claim indefinite because a portfolio can comprise an article but the article cannot comprise the portfolio etc. The claim is indefinite because it is unclear if the claim is drawn to an article, or to a portfolio, desk folder, etc. It has been held that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 37 recites the broad recitation “an article with a printed image thereon,” and the claim also recites “a portfolio, desk folder, wallet, luggage tag, memo pad, or keyfob” which is the narrower statement of the range/limitation.

With regard to claim 37, applicants are attempting to claim that image sheet is “being **welded** on said second side to said member” and also that the RF energy serves to “**adhere** said image sheet to said member.” A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 37 recites the broad recitation “adhere,” and the claim also recites “welded” which is the narrower statement of the range/limitation. Given the fact that applicants see a distinct difference between the words adhere and weld (see Remarks page 11), this provided additional impetus for the Examiner to set forth this rejection; furthermore, for purposes of examination the Examiner will treat the broader limitation adhere.

With further regard to claim 37, the term “predetermined contours” renders the claim indefinite. It is unclear to when predetermined is referring in relation to the time

Art Unit: 1794

frame of the invention. Perhaps applicants meant "cut according to contours of an image printed on the first side thereof."

Claim 37 recites the limitation "the surface" in the ninth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With regard to claim 38, the phrase "said article comprising" in the second line of the claim renders the claim indefinite because a portfolio can comprise an article but the article cannot comprise the portfolio etc. The claim is indefinite because it is unclear if the claim is drawn to an article, or to a portfolio, desk folder, etc. It has been held that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 38 recites the broad recitation "an article with a printed image thereon," and the claim also recites "a

Art Unit: 1794

portfolio, desk folder, wallet, luggage tag, memo pad, or keyfob” which is the narrower statement of the range/limitation.

With further regard to claim 38, applicants are attempting to claim a “cover part further comprising: a member” and also that the member is “comprising at least a portion of said cover part.” It is unclear if these two materials are the same or are different, given the fact that they are both comprised of flexible and indentable material and appear to both comprise each other. The limitations “cover part comprising a member” and “member comprising a cover part” render the claim indefinite because they do not logically make sense when present in the same claim.

Claim 38 recites the limitation “the surface” in the ninth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

With regard to claim 38, applicants are attempting to claim that image sheet is “being **welded** on said second side to said member” and also that the RF energy serves to “**adhere** said image sheet to said member.” A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not

Art Unit: 1794

required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 38 recites the broad recitation "adhere," and the claim also recites "welded" which is the narrower statement of the range/limitation. Given the fact that applicants see a distinct difference between the words adhere and weld (see Remarks page 11), this provided additional impetus for the Examiner to set forth this rejection; furthermore, for purposes of examination the Examiner will treat the broader limitation adhere.

Claim 43 recites the limitation "coating" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this is meant to be the same ink receptive coating as seen in claim 42.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

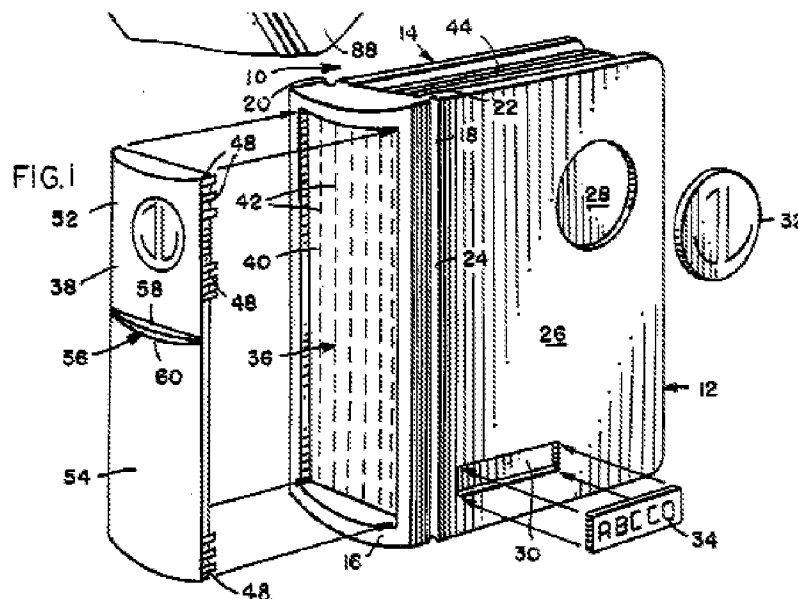
8. Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Errichiello (4,294,469).

The Examiner notes various product-by-process limitations in applicants' claims, including that RF energy is used to adhere/weld said image sheet to said member

Art Unit: 1794

(claim 38) and that the indentation is “debossed...in the surface of the member” (claim 38). It has been held that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any article that has the resulting article limitations will be held to anticipate applicants’ claimed article.

With regard to claim 38, Errichiello disclose the article of Figure 1.



The article is a book binder **10**, which is comprised of a front cover panel **12**, which reads on applicants’ cover part and member (col. 3, lines 15-25). The front cover panel is deemed to be flexible and indentable because it is comprised of thermoplastic

Art Unit: 1794

polymers, which will intrinsically be flexible and indentable. It is also noted that there are living hinges **18** and **20** at which there is flexing (col. 3, lines 26-33) and clearly it is indentable because there are shallow cavities **28** and **30**, which read on applicants' indentations. There are inserts **32** and **34**, which read on applicants' image sheet with a printed image (col. 3, line 38) of a first side thereof (col. 3, lines 34-66). These inserts are intrinsically flexible because they can be embossed (col. 3, lines 53-56). The inserts are bound to the front cover panel at the side opposite the indicia. The front cover panel has shallow cavities **28** and **30**, which read on applicants' planar indentation in a surface of said member. The Examiner deems the shallow cavities to be planar because the Figure shows them to be planar. The inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads on applicants' claimed welding, or press-fitted (col. 2, lines 2-27)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

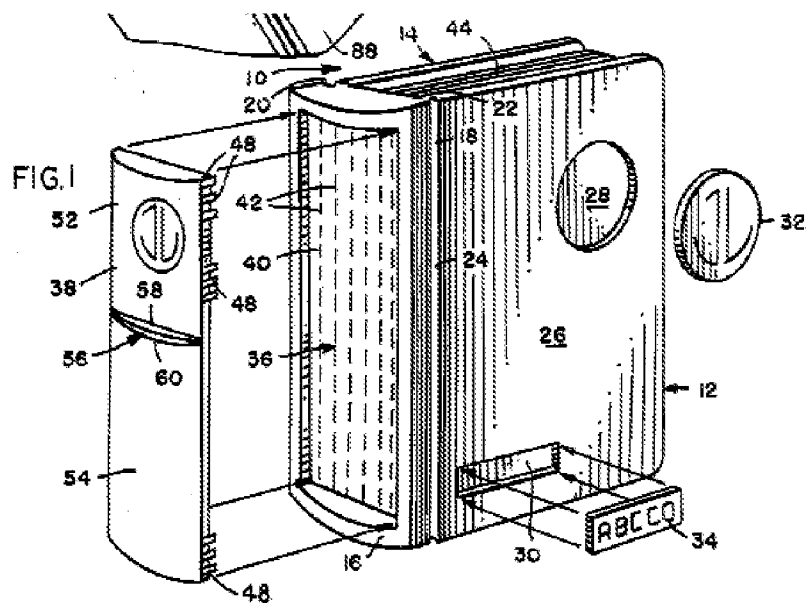
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 29-31, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469).

Art Unit: 1794

The Examiner notes various product-by-process limitations in applicants' claims, including that the "image sheet being bonded...to said member by pressing said member to adhere said image sheet" (claim 29), that RF energy is used to adhere/weld said image sheet to said member (claims 31 and 37), and that there is an "image sheet...cut according to predetermined contours" (claim 37). It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any article that has the resulting article limitations will be held to anticipate/render obvious applicants' claimed article.

With regard to claims 29 and 37, Errichiello disclose the article of Figure 1.



The article is a book binder **10**, which is comprised of a front cover panel **12**, which reads on applicants' cover part and member (col. 3, lines 15-25). The front cover panel is deemed to be flexible and indentable because it is comprised of thermoplastic polymers, which will intrinsically be flexible and indentable. It is also noted that there are living hinges **18** and **20** at which there is flexing (col. 3, lines 26-33) and clearly it is indentable because there are shallow cavities **28** and **30**, which read on applicants' indentations. There are inserts **32** and **34**, which read on applicants' image sheet with a printed image (col. 3, line 38) of a first side thereof (col. 3, lines 34-66). These inserts are intrinsically flexible because they can be embossed (col. 3, lines 53-56). The inserts are bound to the front cover panel at the side opposite the indicia. The front cover panel has shallow cavities **28** and **30**, which read on applicants' indentation in a surface of said member. The inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads

Art Unit: 1794

on applicants' claimed welding, or press-fitted (col. 2, lines 2-27); however, Errichiello does not explicitly state that the indentation in the surface of the member has "a depth at least as great as the thickness of said image sheet.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the indentations in said cover part/member any depth, including at least as great as the thickness of said image sheet, in order to arrive at a book binder that had a cover panel that was smooth while still maintaining structural stability of the cover panel.

With regard to claims 30, 39, and 40, Errichiello describes the inserts **32** and **34** as being molded (col. 3, line 37); furthermore, there is a spine insert **38**, which they describe as being molded from a thermoplastic polymer (col. 2, lines 10-12). It is clear to the Examiner that they front panel inserts are also molded from a thermoplastic polymer.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inserts out of the same thermoplastic polymer as the book binder. The motivation for doing so would have been to save money by using the same material to make both the customizable inserts and the book binder.

With regard to claim 31, the inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads on applicants' claimed welding, or press-fitted (col. 2, lines 2-27). The inserts are bound to the front cover panel at the side opposite the indicia.

Art Unit: 1794

11. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claim 37, in view of Peterson et al. (3,190,678).

Errichiello render obvious all of the limitations of applicants' claim 37 in section 10 above; however they fail to disclose that the flexible plastic material of applicants' image sheet and member are formed of polyvinyl chloride.

Peterson et al. disclose book binders, including covering material comprised of thermoplastic polymers, such as polyvinyl chloride (col. 1, lines 14-16).

Since Errichiello and Peterson et al. are both drawn to thermoplastic polymers for book binders; it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the thermoplastic polyvinyl chloride polymer of Peterson et al. for the thermoplastic polymer of Errichiello. The results of which would have been predictable to one having ordinary skill. The motivation to use polyvinyl chloride is that it is a ubiquitous thermoplastic that is well known for its chemical resistance.

12. Claims 32, 33, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claims 29 and 37, in view of Miyamoto et al. (4,460,637).

Errichiello renders obvious all of the limitations of applicants' claims 29 and 37 in section 10 above; however, they fail to disclose that there is an ink receptive coating on the inserts.

Art Unit: 1794

Miyamoto et al. disclose that it is known to place ink receptive layers on thermoplastic support materials, including polyvinyl chloride (col. 6, lines 47-63).

Since Errichiello and Miyamoto et al. are both drawn to thermoplastic substrates; it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the ink-receptive layers of Miyamoto et al. on the thermoplastic inserts of Errichiello. The results of which would have been predictable to one having ordinary skill. The motivation for doing so can be found at col. 1, lines 5-11 of Miyamoto et al. where they state that their recording sheet has high density and bright colors for the recorded images and also a high rate of ink absorption with a minimum of ink feathering.

With specific regard to claim 33, any surface will intrinsically have a texture. The surface of the support material of Miyamoto et al. and Errichiello will intrinsically possess a texture.

13. Claims 34 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claims 29 and 37, in view of Reed et al. (3,297,341).

Errichiello renders obvious all of the limitations of applicants' claims 27 and 37 in section 10 above; however, they fail to disclose a transparent laminate sheet overlaying said image sheet.

Reed et al. disclose a book protector, which may be a transparent plastic film (col. 2, lines 60-67). The film may have pressure sensitive adhesive on side thereof that

Art Unit: 1794

allows it to be adhered to a book cover (col. 1, line 65 to col. 2, line 6), and hence reads on applicants' transparent laminate sheet.

Since Errichiello and Reed et al. are both drawn to books and book covers; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the book protector of Reed et al. with the book binders of Errichiello. The results of such a combination would have been predictable; further, each of the elements would have performed the same in combination as they had separately. The motivation behind using the book protector is to protect the cover panel and inserts.

14. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) as applied to claims 29, in view of Reed et al. (3,297,341), as applied to claim 34, and further in view of Peterson et al. (3,190,678).

Errichiello in view of Reed et al. render obvious all of the limitations of applicants' claim 34 in section 13 above. The Examiner has already rendered obvious that the cover panel and inserts would be formed on a thermoplastic polymer (see section 10 above); however, Errichiello in view of Reed et al. fail to disclose that the image sheet is formed of polyvinyl chloride.

Peterson et al. disclose book binders, including covering material comprised of thermoplastic polymers, such as polyvinyl chloride (col. 1, lines 14-16).

Since Errichiello in view of Reed et al. and Peterson et al. are drawn to thermoplastic polymers for book binders; it would have been obvious to one having

Art Unit: 1794

ordinary skill in the art at the time the invention was made to substitute the thermoplastic polyvinyl chloride polymer of Peterson et al. for the thermoplastic polymer of Errichiello. The results of which would have been predictable to one having ordinary skill. The motivation to use polyvinyl chloride is that it is a ubiquitous thermoplastic that is well known for its chemical resistance.

Response to Arguments

15. Applicant's arguments, see Remarks, filed 12/09/2008, with respect to the objections to the specification have been fully considered and are persuasive. The objections have been withdrawn.

16. Applicant's arguments, see Remarks, filed 12/09/2008, with respect to the rejection(s) of claim(s) 29-38 based upon either the Jones (3,153,868) or Ambridge et al. (6,224,110) references have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Errichiello (4,294,469).

Applicants' arguments were persuasive with regard to the definition of the term "indentation" as recess in a surface. The Examiner did not show a recess in a surface.

Errichiello shows a recess in a surface, wherein an insert is glued, heat-sealed, or press-fitted into said recess. The concept of an image sheet recesses in the surface of a book cover/binder is well-known.

Applicants argue that a “weld” is clearly different from “pressure-sensitive adhesives.”

The Examiner respectfully disagrees and notes that the broadest reasonable interpretation of the word “weld” according to Merriam-Webster Online “**2**: to unite or reunite closely or intimately.” A pressure-sensitive adhesive would read on this definition of the word weld.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner has cited various patents relating to a sheet comprising a variation in its thickness combined with a material filling in the shallow areas. Note is made of US 4,153,275, which is a checkbook cover with a depressed flat area wherein inserts can be placed (Abstract), a light-collimating film US 5,204,160, and linoleum floor coverings US 1,691,708.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins
Examiner
Art Unit 1794

/Gerard T Higgins/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794